

### **REMARKS/ARGUMENTS**

The office action of November 4, 2003 has been carefully reviewed and these remarks are responsive thereto. Applicants thank the examiner for withdrawing the finality of the Office Action. Claims 1, 3-8, 10, 12-17, 19 and 21-22 remain pending. Reconsideration and allowance of the instant application are respectfully requested.

#### ***Objection to Drawings***

The cover page of the November 4, 2003 Office Action objects to the formal drawings filed November 7, 2001. However, no specific objection is provided in the body of the Office Action, and no draftsman's objection sheet has been received by Applicants. Applicants respectfully request clarification of the drawing objection.

#### ***Rejections Under 35 U.S.C. § 103***

Claims 1, 3-8, 10, and 12-17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung *et al.* (U.S. Pat. No. 6,570,583 B1, hereinafter Kung) in view of Williams *et al.* (U.S. Pat. No. 5,542,138, hereinafter Williams). Applicants respectfully traverse this rejection for at least the following reasons.

Claim 1 recites, inter alia, "a display screen on the front of the device; a first user input control on the back of the device, ...; and a second user input control on the back of the device...." The Office Action concedes that Kung does not teach or suggest first and second input controls located on the back of the device (11/4/03 Office Action, p. 2). However, the Office Action maintains that Kung can be combined with Williams to teach or suggest this feature. Applicants previously argued that there is no motivation or suggestion to combine Kung with Williams, however the Examiner found Applicants' arguments unpersuasive. The Nov. 4, 2003 Office Action further indicates on page 9 that there are suggestions to combine in both Kung and Williams. Specifically, the Office Action cites Kung, Col. 2, lines 17-18 and Williams, Col. 2, lines 9-11. However, neither the cited portions of the references nor any other portion of the references provide a suggestion or motivation to combine Kung, which describes a

zoom-enabled handheld device, with Williams, which describes a bedside control unit for a hospital bed.

More specifically, Kung, at col. 2, lines 15-18, states "the zoom control device, in conjunction with the display program, allows the user to quickly change the size of text and icons on the display." This does not suggest that the Kung device can be modified or combined with a bedside control unit for a hospital bed. Williams, at col. 2, lines 9-11, states "[t]he keyboard allows entry of patient data into the control module which can subsequently be viewed on the display." Likewise, this does not suggest that the Williams bedside control unit can be combined with a zoom-enabled handheld device. The only commonality between the two appears to be that they both have a display. However, applicants respectfully submit that this does not rise to the level of a suggestion or motivation to combine such that one of ordinary skill in the art would combine the references. If it did, then arguably any two devices with displays could be combined, regardless of how disparate their technological areas may be.

The Final Office Action further indicates that page 3 of the Final Office Action provides additional motivation to combine the references. Page 3 of the Final Office Action states, "[i]t would have been obvious to one of ordinary skill in the art at the time of the invention to implement user input control on a back of the control module as shown by Williams et al. in the Kung et al. apparatus in order to user [sic] quickly change the size of text and icons on the display and allow entry of patient data into the control module which can subsequently be viewed on the display." This does nothing more than repeat the already cited portions of the Kung and Williams references, which, as Applicants have shown above, do not provide a suggestion or motivation to combine the references. The combination of Kung and Williams is nothing more than piecing together references based on the claim, which is impermissible hindsight.

The Federal Circuit has repeatedly stated that the limitations of a claim in a pending application cannot be used as a blueprint to piece together prior art in hindsight, *In re Dembiczak*, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999), and that the Patent Office should *rigorously* apply the requirement that a teaching or motivation to combine prior art references needs to be provided. *Id.* (emphasis added). Thus, Applicants respectfully submit that that there is no

motivation or suggestion to combine Kung, which describes a zoom-enabled handheld device, with Williams, which describes a bedside control unit for a hospital bed. Should the Office maintain this rejection, the examiner is respectfully requested to provide a suggestion or motivation within the references themselves, or provide evidence of the level of knowledge of one of ordinary skill in the art, that would support such a combination.

Even if the Kung and Williams are combined, the combination does not teach or suggest every element of claim 1. Specifically, in Kung, the Office Action concedes that the display and the input controls are on the front of the device. In Williams, when the device is in the open configuration, as is shown in Williams Fig. 3, the display 70 and the input control 74 are both on the back side of the device (Applicants make no concession, as is suggested in the Final Office Action, that Williams meets all the limitations of any claim). Thus, even if Kung and Williams are combined, the combination does not teach or suggest a display on one side of a device, and input controls on another.

Claims 19, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kung in view of Conway *et al.* (U.S. Pat. No. 5,278,779, hereinafter Conway) and further in view of Wang (U.S. Pat. No. 5,771,038). Applicants respectfully traverse this rejection.

Applicants submit there is no motivation or suggestion to combine Kung with Conway and/or Wang. Kung describes a zoom-enabled handheld device; Conway describes a laptop computer with hinged keyboard; and Wang describes a control device (i.e., a mouse) for display state change on a monitor. The Office Action states, as it did with the previous rejection, only the results of the combination. The Office Action does not provide any suggestion or motivation in the references themselves or in the level of knowledge of one of ordinary skill in the art to combine the cited references. Should the Office maintain this rejection, the examiner is respectfully requested to provide a suggestion or motivation within the references themselves, or provide evidence of the level of knowledge of one of ordinary skill in the art, that would support such a combination.

**CONCLUSION**

It is believed that no fee is required for this submission. If any fees are required or if an overpayment is made, the Commissioner is authorized to debit or credit our Deposit Account No. 19-0733, accordingly.

All rejections having been addressed, applicant respectfully submits that the instant application is in condition for allowance, and respectfully solicits prompt notification of the same. However, if for any reason the Examiner believes the application is not in condition for allowance or there are any questions, the examiner is requested to contact the undersigned at (202) 824-3153.

Respectfully submitted,

BANNER & WITCOFF, LTD.

Dated this 15<sup>th</sup> day of December, 2003

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